



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/558,057	11/22/2005	Soon Ook Hwang	2017-047	1102				
52706 IPLA P.A. 3580 WILSHIRE BLVD. 17TH FLOOR LOS ANGELES, CA 90010	7590 12/31/2007		<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">LILLING, HERBERT J</td></tr></table>		EXAMINER		LILLING, HERBERT J	
EXAMINER								
LILLING, HERBERT J								
			<table border="1"><tr><td>ART UNIT</td><td>PAPER NUMBER</td></tr><tr><td>1657</td><td></td></tr></table>	ART UNIT	PAPER NUMBER	1657		
ART UNIT	PAPER NUMBER							
1657								
			<table border="1"><tr><td>MAIL DATE</td><td>DELIVERY MODE</td></tr><tr><td>12/31/2007</td><td>PAPER</td></tr></table>	MAIL DATE	DELIVERY MODE	12/31/2007	PAPER	
MAIL DATE	DELIVERY MODE							
12/31/2007	PAPER							

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/558,057

Applicant(s)

HWANG ET AL.

Examiner

HERBERT J. LILLING

Art Unit

1657

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date November 22, 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. Receipt is acknowledged of a prior art information disclosure statement filed on November 22, 2005 for this application which is a 371 of PCT/KR04/01313 filed June 02, 2004 which claims benefit of Republic of Korea 10-2003-0035470 filed 06/03/2003.

2. Claims 1 -3 are present in this application.

3. Applicant is required to submit a separate drawing Figure 1 for Scheme 1.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention absent the "general formula" 1, 2 and 3 in the claims.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention in view of the lack of a definite structure for the formulas in the scheme as submitted on page one of the specification.

Claim 2 is not enabled for all of the claimed R's submitted based on the instant specification for the nitrogen containing component.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianchi et al U.S. 5,231,027 alone or further in view of Gutman et al. Volume 4, Issue 5, May 1993, Pages 839-844.

Bianchi et al teaches especially in Column 8 Example 4 the separation of enantiomers of tosyl 1-2 propanediol which includes an immobilized lipase in the presence of an anhydride. Bianchi et al does not recite succinic anhydride but only indicates two preferred anhydrides.

Gutman et al teaches the utilization of succinic anhydride as an acylating agent in the resolution of racemic alcohols.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

It would have been prima facie obvious to one of ordinary skilled in the art to substitute the anhydride of Gutman et al for that of Bianchi et al since one of ordinary skilled in the art would reasonably expect the reaction to occur in the same manner. The claimed subject matter lack any patentable distinctions over the prior art.

Further, in light of the Supreme Court's recent decision in *KSR International Co. v. Teleflex Inc (TFX)* ., 82 USPQ2d 1385 (2007) based on the reasoning may still include the established Court of Appeals for the Federal Circuit standard that a claimed invention may be obvious if the examiner identifies a prior art teaching, suggestion, or motivation (TSM) to make it. However, the Guidelines explain that there is no requirement that patent examiners use the TSM approach in order to make a proper obviousness rejection. Furthermore, the Guidelines point out that even if the TSM

approach cannot be applied to a claimed invention that invention may still be found obvious.

If there are any differences with respect to the claimed subject matter and the general knowledge pertaining to the art in the area, that these differences would have been prima facie obvious to one of ordinary skilled in the pertinent art whether it was based on the art of record or claimed subject would have obvious for the "combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results".

Further in view of "In U.S. v Adams...." Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the filed, the combination must do more than yield a predictable result."

The use of one specific known acylating agent for another is prima facie evidence that the claimed subject matter lacks any patentable distinction over the art of record.

Furthermore in view of ".Sakraida v. AG Pro Inc., ...the conclusion that when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious."

Each of the elements or compounds as claimed perform the same function and yields no more than one would expect from such a reaction.

The Supreme stated the following:

"When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, 35 .S.C. 103 bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve a similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."

As indicated in the above substitution of Gutman et al for that of Bianchi et al it would have been considered for a person of ordinary skilled in the art would recognized the similarity of the reaction mechanism and using the same way and techniques would have been obvious to the person of ordinary skilled in the art.

The KSR Decision requires rationales to support the rejections under 35 USC 103. The first issue is to analyze the Graham factual inquiries as noted above for obviousness based on the prior art but the prior art is not limited to references but includes the basic knowledge and understanding of one skill in the pertinent art. Thus, the prior art alone or in combination does not have to teach or suggest or motivate one all of the limitations of the claimed limitations but there must be some rationale to explain these differences would have been obvious to one of ordinary skill in the art

7. **No claim is allowed.**

8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lilling whose telephone number is 571-272-0918 and Fax Number is **571-273-8300**, or SPE Jon Weber whose telephone number is 571-272-0925. Examiner can be reached Monday-Friday from about 7:30 A.M. to about 7:00 P.M. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Application/Control Number:
10/558,057
Art Unit: 1657

Page 7

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.J.Lilling: HJL
(571) 272-0918
Art Unit 1657
December 27, 2007



Dr. Herbert J. Lilling
Primary Examiner
Group 1600 Art Unit 1657